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Filing date: **03/29/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92045000
Party	Plaintiff Bass Pro Trademarks, L.L.C. Bass Pro Trademarks, L.L.C.  Bass Pro Trademarks, L.L.C. 2500 East Kearney Springfield, MO 65898 UNITED STATES
Correspondence Address	Dennis J.M. Donahue III Husch & Eppenger, LLC 190 Carondelet Plaza Suite 600 St. Louis, MO 63105 UNITED STATES trademark@husch.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Dennis J.M. Donahue III
Filer's e-mail	trademark@husch.com
Signature	/Dennis J.M. Donahue III/
Date	03/29/2006
Attachments	69996-14 Mtn and Amd Pet.pdf ( 21 pages )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 2,390,988

For the mark SPORTSMAN'S WAREHOUSE HUNTING FISHING CAMPING RELOADING  
OUTERWEAR FOOTWEAR and Design

Date registered:        October 3, 2000

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Bass Pro Trademarks, L.L.C.,	:	CANCELLATION NO. 92045000
PETITIONER,	:	
	:	
v.	:	
	:	
Sportsman's Warehouse, Inc.,	:	
RESPONDENT	:	
-----		

**PETITIONER'S MOTION FOR LEAVE TO FILE  
AMENDED PETITION FOR CANCELLATION**

COMES NOW Petitioner Bass Pro Trademarks, LLC ( "Petitioner" or "Bass Pro"), by and through their undersigned counsel, and hereby respectfully request leave of the Board to file its Amended Petition for Cancellation, filed herewith as Exhibit 1. Bass Pro states the following grounds in support of its motion:

1. Bass Pro filed its original Petition for Cancellation on September 30, 2005.
2. The grounds for cancellation stated in Bass Pro's original Petition included (i) that there is a likelihood of confusion between Respondent Sportsman's Warehouse, Inc.'s ("Respondent") registered mark and Bass Pro's cited registered mark, which is the subject of its own registration filed prior to Respondent's application for its registration, and (ii) that Respondent's registered mark is merely descriptive of the services being provided thereunder.

3. At the time of filing its original Petition for Cancellation, Bass Pro suspected that Respondent does not, and had not at anytime, used its registered mark in connection with all of the services listed in its application and resulting registration. However, cognizant of its duties under Fed. R. Civ. P. 11, Bass Pro refrained from making such an allegation until such time as it could confirm its suspicions.

4. In its responses to Bass Pro's first set of discovery requests in the pending matter, Respondent confirmed Bass Pro's suspicions by clearly admitting that Respondent does not and has not used its registered mark in connection with wholesale stores despite the fact that Respondent expressly declared that its mark was in actual use in connection with such services. See Exhibit B to Bass Pro's Amended Petition for Cancellation.<sup>1</sup> These responses and the documents produced by Respondent also indicate that Respondent has misused the federal registration symbol, ®, in asserting to third parties that it possesses a federal registration in the phrase SPORTSMAN'S WAREHOUSE by itself. Bass Pro received these responses in late February.

5. Bass Pro's Amended Petition for Cancellation adds two counts. The first is directed to Respondent's submission of a fraudulent allegation of use with its application for the registered mark. The second relates to Respondent's misuse of the federal registration symbol. Both of these are recognized grounds for cancellation of a registration. See 15 U.S.C. §1064(3); *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 U.S.P.Q.2d 1295 (Fed. Cir. 1991) (fraudulent misuse of the registration symbol is a ground for a petition to cancel).

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<sup>1</sup> Exhibit B to Bass Pro's Amended Petition for Cancellation consists of Respondent's responses to Bass Pro's first set of discovery requests relating to the scope of Respondent's use of its registered mark. Because Respondent has elected to designate all of its responses to these discovery requests as "Confidential" pursuant to the Protective Order in place in this opposition, Bass Pro is filing this Exhibit as a confidential document separately from this motion.

6. Amendments to a Petition for Cancellation are appropriate. *See* 37 C.F.R. §2.115 (“Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.”); Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §315, 507. Fed. R. Civ. P. 15 provides that a party may amend its pleading by leave of court after a response to its original pleading is served and that “leave shall be freely given when justice so requires.” The Board will liberally grant leave to amend pleadings, even where the petitioners seeks to plead an additional claim, “unless entry of the proposed amendment would violate settle law or be prejudicial to the rights of the adverse party ... .” TBMP §507.02.

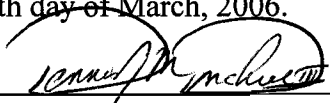
7. There is absolutely no evidence that entry of Bass Pro’s Amended Petition will violate settled law or prejudice Respondent in anyway. Discovery in this opposition is ongoing, and, to the extent the Board deems necessary, Bass Pro will stipulate to an extension of the discovery period. *See e.g. Polaris Industries Inc. v. DC Comics*, 59 U.S.P.Q.2d 1798, 1800 (TTAB 2000). Further, both of the additional counts in Bass Pro’s Amended Petition have been addressed, at least initially, in written discovery. In addition, as the parties have yet to take any discovery depositions in this matter, the entry of these two new claims will not necessitate the retaking of any depositions. Finally, Bass Pro has acted expeditiously in filing this motion to amend its petition approximately within a month of receiving Respondent’s discovery responses containing the information supporting these new claims.

8. Pursuant to TBMP §507.01, a signed copy of Bass Pro’s Amended Petition for Cancellation accompanies this motion as Exhibit 1 hereto. As mentioned above, Exhibit B to Bass Pro’s Amended Petition for Cancellation consists of Respondent’s responses to Bass Pro’s first set of discovery requests relating to the scope of Respondent’s use of its registered mark.

Because Respondent has elected to designate all of its responses to these discovery requests as “Confidential” pursuant to the Protective Order in place in this opposition, Bass Pro is filing this Exhibit as a confidential document separately from this motion.

WHEREFORE Petitioner Bass Pro Trademarks, LLC respectfully requests the Board grant leave to Bass pro to file its Amended Petition for Cancellation and enter such Amended Petition accordingly.

Respectfully submitted, this 29th day of March, 2006.



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Dennis J.M. Donahue III  
Husch & Eppenberger, LLC  
190 Carondelet Plaza, Suite 600  
St Louis, MO 63105  
Phone 314-480-1642  
Fax 314-290-5342  
E-mail trademark@husch.com

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and correct copy of the foregoing Petitioner's Motion for Leave to File Amended Petition for Cancellation was served by first class mail, postage prepaid, on Garrett M. Weber, Lindquist & Vennum, PLLP, 80 South 8<sup>th</sup> Street, 4200 IDS Center, Minneapolis, MN 55402-2205, the attorney for Respondent, on this 29th day of March, 2006.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark Registration No. 2,390,988

For the mark SPORTSMAN'S WAREHOUSE HUNTING FISHING CAMPING RELOADING  
OUTERWEAR FOOTWEAR and Design

Date registered: October 3, 2000

Bass Pro Trademarks, L.L.C	)	
	)	
v.	)	Cancellation No. 92045000
Sportsman's Warehouse, Inc.	)	

AMENDED PETITION TO CANCEL

Petitioner is BASS PRO TRADEMARKS, L.L.C., a Limited Liability Company organized and existing under the laws of Missouri, located and doing business at 2500 E. Kearney, Springfield, Missouri 65898 ("Petitioner").

To the best of Petitioner's knowledge, the name and address of the current owner of the registration are as follows: Sportsman's Warehouse, Inc. (Utah Corporation), 7035 High Tech Drive, Midvale, Utah 84047 ("Respondent").

The above-identified Petitioner believes that it will be damaged by the above-identified registration, and hereby amends its original petitions to cancel the same.

The grounds for cancellation are as follows:

1. Petitioner is the owner of U.S. Trademark Registration No. 2071417 for the mark BASS PRO SHOPS SPORTSMAN'S WAREHOUSE and Design which was registered on the Principal Register on June 17, 1997. Said registration was based on an application filed in the U.S. Patent Office on March 1, 1996, which is a date prior to the date of filing of Respondent's application. Said registered mark of Petitioner is valid and subsisting and is prima facie evidence

of Petitioner's exclusive right to use said mark in commerce on the services specified in said registration, namely "retail stores featuring clothing, fishing supplies and sporting goods." In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that Respondent's registered mark so resembles Petitioner's registered mark, as to be likely to cause confusion, or to cause mistake, or to deceive.

2. Respondent's registered mark, when used in connection with the services of respondent, is comprised of a background design and terms that are merely descriptive of the services being provided and that are insufficiently stylized to be inherently distinctive to consumers in the markets served by Respondent.

3. Respondent's registered mark, when used in connection with the services of respondent, is comprised of a common background design and terms that are merely descriptive of the services being provided and that are stylized in a common format (western/frontier) that fails to create a separate and distinct impression necessary for a mark in the markets served by respondent.

4. Since at least as early as January 2, 1995, Petitioner has been using the mark SPORTSMAN'S WAREHOUSE in connection with retail store services. Said use has been valid and continuous since said date of first use and has not been abandoned. Said use was begun on a date prior to the date of filing of Respondent's application. Said mark of Petitioner is symbolic of extensive good will and consumer recognition built up by Petitioner through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged



that Respondent's registered mark so resembles Petitioner's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

5. Since at least as early as January 2, 1995, Petitioner has been using the mark SPORTSMAN'S WAREHOUSE in connection with retail store services. Said use has been valid and continuous since said date of first use and has not been abandoned. Said use was begun on a date prior to the actual date of first use of the Respondent's registered mark and prior to the Respondent's claimed date of first use. (Upon information and belief, Petitioner further alleges that Respondent's actual date of first use of the registered mark was after the date set forth in the application.) Said mark of Petitioner is symbolic of extensive good will and consumer recognition built up by Petitioner through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that Respondent's registered mark so resembles Petitioner's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

6. Respondent's registration was obtained fraudulently in that in the formal application papers filed by respondent under notice of 18 U.S.C. § 1001, it was stated that Respondent had used the SPORTSMAN'S WAREHOUSE and Design mark since June 16, 1995, in connection with "[r]etail and wholesale stores featuring hunting supplies, fishing supplies, camping supplies, reloading supplies, outerwear clothing and footwear." See Exhibit A, Respondent's Application for Registration (emphasis added). Stuart B. Utgaard, president of Respondent signed the declaration for the application on behalf of Respondent. *Id.* Said statement was false in that Respondent has not at any time used the SPORTSMAN'S

WAREHOUSE mark in any form in connection with wholesale stores. Respondent has admitted this fact during discovery associated with the pending proceeding. *See* Exhibit B, Respondent's Answer to Petitioner's Interrogatories.<sup>1</sup>

7. The foregoing false statement was made by Respondent with the knowledge that said statement was false. The statement was also confirmed in a subsequent response to an office action issued in connection with the application by Respondent's authorized agent. *See* Exhibit C, February 7, 2000 Response. Said false statements was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant Respondent's registration and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to Respondent.

8. Upon information and belief, Respondent has misused the statutory registration notice (Registered Trademark and/or ®) that it obtained for the mark shown in Registration No. 2,390,988 by using such notice in connection with correspondence asserting that Respondent owns a federal registration for the word mark SPORTSMAN'S WAREHOUSE, by itself and without any other terms, visual elements, or stylization, and ordering third parties, in particular, others in the trade of retail sales of sporting goods, hunting supplies, fishing, supplies, and clothing, to cease and desist use of the SPORTSMAN'S WAREHOUSE word mark. Such misuse was intended to deceive others in the trade into believing that Respondent possessed a registration in the word mark SPORTSMAN'S WAREHOUSE.

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<sup>1</sup> Exhibit B to Bass Pro's Amended Petition for Cancellation consists of Respondent's responses to Bass Pro's first set of discovery requests relating to the scope of Respondent's use of its registered mark. Because Respondent has elected to designate all of its responses to these discovery requests as "Confidential" pursuant to the Protective Order in place in this opposition, Bass Pro is filing this Exhibit as a confidential document separately from this Amended Petition.

9. Upon information and belief, Respondent has misused the statutory registration notice (Registered Trademark and/or ®) that it obtained for the mark shown in Registration No. 2,390,988 by using such notice in numerous advertisements to the public in a partial version of the logo mark, i.e., without including the terms HUNTING FISHING CAMPING RELOADING OUTERWEAR FOOTWEAR, terms Respondent had so carefully used to distinguish its mark from that of Petitioner's prior registration (Reg. No. 2071417) when asserting that the logo mark should be registered. Respondent's assertion of a registration to the word mark SPORTSMAN'S WAREHOUSE and partial versions of the logo mark are part of Respondent's reckless disregard for the proper marking of the logo mark actually registered in Registration No. 2,390,988.

WHEREFORE, Petitioner prays that Registration No. 2,390,988 be cancelled and that this Amended Petition for Cancellation be sustained in favor of Petitioner.

Petitioner hereby appoints Dennis J.M. Donahue III, Michael D. Bokermann, Rebecca J. Brandau, Dutro E. Campbell II, David A. Chambers, Robert C. Haldiman, Grant D. Kang, Ryan Mitchem, Harry B. Ray, H. Frederick Rusche, and Gregory E. Upchurch of the firm Husch & Eppenberger, LLC, to act as attorneys for Petitioner herein, with full power to prosecute said Petition and to transact all relevant business with the U.S. Patent and Trademark Office and the United States Courts. **Dennis J.M. Donahue III** is hereby authorized to receive all official communications in connection with this Petition for Cancellation.

Respectfully submitted, this 29th day of March, 2006.



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Dennis J.M. Donahue III  
Husch & Eppenberger, LLC  
190 Carondelet Plaza, Suite 600  
St Louis, MO 63105  
Phone 314-480-1642  
Fax 314-290-5342  
E-mail [trademark@husch.com](mailto:trademark@husch.com)

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and correct copy of the foregoing Amended Petition for Cancellation with Exhibits 1-3 was served by first class mail, postage prepaid, on Garrett M. Weber, Lindquist & Vennum, PLLP, 80 South 8<sup>th</sup> Street, 4200 IDS Center, Minneapolis, MN 55402-2205, the attorney for Respondent, on this 29th day of March, 2006.

A handwritten signature in cursive script, reading "Mary H. Johnson-Jumper", written over a horizontal line.

## **EXHIBIT A**

**SERVICE MARK APPLICATION,  
PRINCIPAL REGISTER, WITH  
DECLARATION**

**MARK: SPORTSMAN'S WAREHOUSE  
HUNTING FISHING CAMPING RELOADING  
OUTERWEAR FOOTWEAR and Design  
CLASS NO. 42**

**TO THE ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND  
TRADEMARKS:**

Applicant Name: Sports Warehouse, Inc.

Applicant Business Address: 7035 South 185 West  
Midvale, Utah 84047

Applicant Entity:

Applicant is a corporation organized under the laws of the State of Utah

Services:

Applicant requests registration of the above-identified service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended) for the following services: Retail and wholesale stores featuring hunting supplies, fishing supplies, camping supplies, reloading supplies, outerwear clothing and footwear.

Basis for Application:

Applicant is using the mark in commerce on or in connection with the above-identified services. (15 U.S.C. 1051(a), as amended.) Three specimens showing the mark as used in commerce are submitted with this application.

- Date of first use of the mark anywhere: June 16, 1995
- Date of first use of the mark in commerce which the U.S. Congress may regulate: June 16, 1995
- Specify the type of commerce: Interstate
- Specify the manner or mode of use of mark on or in connection with the services: the mark is used in advertising and promotional materials.

Disclaimers

The applicant makes no claim to the exclusive right to use "Sportsman's Warehouse" apart from the mark as shown.

The applicant disclaims the following individual words; "Hunting," "Fishing," "Camping," "Reloading," "Outerwear" and "Footwear" apart from the mark as shown.

## POWER OF ATTORNEY

Please recognize Bruce H. Little, member of the Bar of the State of Minnesota, and member of the law firm of Lindquist & Vennum P.L.L.P., 4200 IDS Center, 80 South Eighth Street, Minneapolis, Minnesota 55402 to prosecute this application to register, to transact all business in connection therewith, and to receive the certificate.

## DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant; he believes the applicant to be the owner of the service mark sought to be registered, or, if the application is being filed under 15 U.S.C. 1051(b), he believes applicant to be entitled to use such mark in commerce; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated:

Sports Warehouse, Inc.

12/16/98

By

Stuart B. Hyman

Its

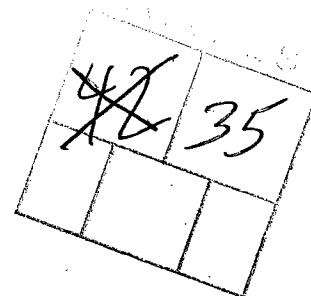
President



01-22-1999

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #10

# DRAWING



**APPLICANT NAME:** Sports Warehouse, Inc.

**APPLICANT ADDRESS:** 7035 South 185 West  
Midvale, Utah 84047

**DATE OF FIRST USE:** June 16, 1995

**DATE OF FIRST USE IN  
COMMERCE:** June 16, 1995

**GOODS:** Retail and wholesale stores featuring hunting supplies,  
fishing supplies, camping supplies, reloading supplies,  
outerwear clothing and footwear.

3511



**PUBLISHED**  
07/11/00

**TRADEMARK**



75625000



75625090

# Just In Time For Father's Day



## Sportsman's Warehouse opens new store in Provo

*Now With Two Great Stores To Serve You!*

Hodgman • Danner • Hi-Tec • Timberland • Merrell •  
Lacrosse • Sorel • Columbia • Browning • Wrangler  
(Rugged Wear) • Carhartt • Nikon • Pentax • Buck • Gurber  
• Leatherman • Zeiss • Kershaw • Bushnell • Coleman •  
Slumberjack • Old Town • Lodge • Camp Chef • Wenzel •  
Remington • Winchester • Ruger • Federal • Smith &  
Wesson • Bennelli • Casco • Leupold • RCBS • Zebco •  
Shakesphere • Plano • Lowrance • Minn Kota • Caddis •  
G. Loomis • Leigh Outdoors • Shimano • Troutsman

**SPORTSMAN'S**  
**WAREHOUSE**  
HUNTING • FISHING • CAMPING • RELOADING • OUTDOORWEAR • FOOTWEAR

7035 S. 185 West. Midvale • 566-6662  
1075 South University Ave. Provo • 818-2000  
• Mon-Thurs 9:30-7:00 • Friday 9:30-8:00 •  
• Saturday 9:00-6:00 • Closed Sunday •

## **EXHIBIT C**

110

# LINDQUIST & VENNUM P.L.L.P.

4200 IDS CENTER  
80 SOUTH EIGHTH STREET  
MINNEAPOLIS, MN 55402  
TELEPHONE: 612-371-3211  
FAX: 612-371-3207



02-09-2000

U.S. Patent & TMO/TM Mail Rcpt Dt. #57

IN ST. PAUL:  
LINDQUIST & VENNUM P.L.L.P.  
444 CEDAR STREET, SUITE 1700  
ST. PAUL, MN 55101  
TELEPHONE: 651-312-1300  
FAX: 651-223-5332

IN DENVER:  
LINDQUIST, VENNUM & CHRISTENSEN P.L.L.P.  
600 17TH STREET, SUITE 1800 SOUTH  
DENVER, CO 80202  
TELEPHONE: 303-573-5900  
FAX: 303-573-1956

ATTORNEYS AT LAW

BRUCE H. LITTLE  
612-371-2437  
blittle@lindquist.com

www.lindquist.com

29A

February 7, 2000

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, certified mail, return receipt requested in an envelope addressed to:

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

on 2/7/2000

Date

Signature

Bruce H. Little

Typed or printed name of person signing certificate

Ms. Linda E. Blohm  
Trademark Examining Attorney  
United States Patent and Trademark Office  
Law Office 110  
2900 Crystal Drive  
Arlington, VA 22202-3513

**VIA CERTIFIED MAIL**  
**RETURN RECEIPT REQUESTED**

Re: **Mark:** SPORTSMAN'S WAREHOUSE HUNTING FISHING  
CAMPING RELOADING OUTERWEAR FOOTWEAR & Design  
**Serial No.:** 75/625090  
**Our File No.:** 433225-0007  
**Office Action Date:** August 6, 1999

Dear Ms. Blohm:

We are in receipt of Office Action No. 1 with regard to the above-referenced mark, and we respond on behalf of Applicant.

RECEIVED  
2000 FEB 11 P 3:44  
TMO  
LAW OFFICE 110

LINDQUIST & VENNUM P.L.L.P.

Ms. Linda E. Blohm

February 7, 2000

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**THERE IS NO LIKELIHOOD OF CONFUSION**

The Examining Attorney initially refused registration of Applicant's mark pursuant to 15 U.S.C. § 1052(d) because the mark is allegedly confusingly similar to the registered mark "BASS PRO SHOPS SPORTSMAN'S WAREHOUSE," U.S. Registration No. 2,071,417. Despite the Examining Attorney's contention that the marks are confusingly similar, the marks are sufficiently distinct and registration should issue. Moreover, because of the Examining Attorney's amendment re-classifying the services in Class 35, the already remote likelihood that Applicant's mark will be confused with the BASS PRO SHOPS mark has been reduced.

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison but rather whether the marks are sufficiently similar so that there is a likelihood of confusion as to the source of the good or services. In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. TMEP § 1207.01(b) (citing Sealed Air Corp. v. Scott Paper Co., 190 U.S.P.Q. 106, 109 (TTAB 1975)).

Although both marks contain the phrase "Sportsman's Warehouse," the overall commercial impression created by the marks is distinct. The mark cited by the Examining Attorney features prominently the phrase "BASS PRO SHOPS" in a distinctive design in the form of an open-mouthed fish (a bass). The phrase "BASS PRO SHOPS" does not appear anywhere in the Applicant's mark. Nor does there appear in Applicant's mark the design of a fish.

By contrast, Applicant's mark contains a design featuring mountains and the words "HUNTING FISHING CAMPING RELOADING OUTERWEAR FOOTWEAR." None of those words appear anywhere in the "BASS PRO SHOPS" mark cited by the Examining Attorney. Applicant's mark prominently features a design of mountains, while the "BASS PRO SHOPS" mark is predominantly an open-mouthed fish. Due to the numerous differences in the visual impressions created by the marks, there is no likelihood of confusion.

The only feature the two marks share is the phrase "Sportsman's Warehouse." The owner of the "BASS PRO SHOPS" mark made the following disclaimer: "No claim is made to the exclusive right to use "SPORTSMAN'S WAREHOUSE" apart from the mark as shown." Similarly, Applicant affirmatively disclaimed the exclusive right to use the term "Sportsman's Warehouse." A disclaimer in a trademark registration amounts to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component

## LINDQUIST & VENNUM P.L.L.P.

Ms. Linda E. Blohm

February 7, 2000

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standing alone, but rights are asserted in the composite. TMEP § 1213 (citing Sprague Electric Co. v. Erie Resistor Corp., 101 U.S.P.Q. 486, 486-87 (Comm'r Pats. 1954)). Thus, because the owner of the "BASS PRO SHOPS" mark has disclaimed the exclusive right to use the phrase "SPORTSMAN'S WAREHOUSE," that phrase should not prevent the Applicant from obtaining a registration for its dissimilar mark containing the same descriptive phrase. As noted above, numerous differences exist between the marks, and there is only one similarity. Because the only similarity between the marks is a descriptive phrase that has been disclaimed by the owners of both marks, registration must issue.

In addition, Registration No. 2,071,417 was issued to Bass Pro Trademarks L.P. in International Class 42, "Miscellaneous" for "Retail stores featuring clothing, fishing supplies and sporting goods." Applicant seeks registration in Class 35, "Advertising and business" for a much broader variety of services: "Retail and wholesale stores featuring hunting supplies, fishing supplies, camping supplies, reloading supplies, outerwear clothing and footwear." At a minimum, Applicant should be permitted to amend to delete the phrase "fishing supplies" from its description of services, and registration should issue.

A registration is indicative of "the registrant's exclusive right to use the mark in commerce on or in connection with the goods or services specified in the certificate." 15 U.S.C. § 1057(b). Even if a mark is registered, "the presumption of an exclusive right to use it extends only so far as the goods or services noted in the registration certificate." Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 48 (2d Cir. 1978). Even an incontestable mark – and the "BASS PRO SHOPS" mark is not incontestable – does not permit a registrant to claim rights over a greater range of products than he would otherwise be entitled to claim. Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366, 377 (7th Cir. 1976); Sunmark, Inc. v. Ocean Spray Cranberries, Inc., 64 F.3d 1055, 1058 (7th Cir. 1995).

The "BASS PRO SHOPS" registration and Applicant's mark have in common only the descriptive phrase "SPORTSMAN'S WAREHOUSE." Use of that disclaimed phrase is not a proper basis for extending the scope of the Registrant's mark and denying registration to Applicant.

### LINING/STIPPLING STATEMENT

✓ The lining and stippling shown in the drawing are not intended to indicate color. *WINT*

LINDQUIST & VENNUM P.L.L.P.

Ms. Linda E. Blohm

February 7, 2000

Page 4

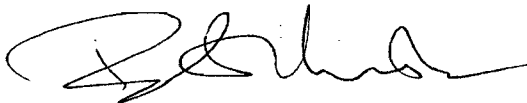
DISCLAIMER

No claim is made to the exclusive right to use "SPORTSMAN'S WAREHOUSE  
HUNTING • FISHING • CAMPING • RELOADING • OUTERWEAR • FOOTWEAR" apart  
from the mark as shown.

CLASSIFICATION

The Application is amended to classify the goods in International Class 35.

LINDQUIST & VENNUM P.L.L.P.



Bruce H. Little

cc: Enterprise Investments, Inc.

PRINT